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Paper No. 7

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FEB 19 2004

OFFICE OF PETITIONS

In re Application of
Jian Gu
Application No. 09/922,019
Filed: August 2, 2001
Attorney Docket No. **5281P006**

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: ON PETITION
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This is a decision on the petition first filed July 7, 2003, and in duplicate on January 14, 2004. The petition is titled, "Request for Withdrawal of Petition for Revival (Request for Refund)." The petition will be treated under 37 CFR 1.182

The petition is **dismissed**.

Petitioner requests that the decision mailed September 30, 2003, granting the petition under 37 CFR 1.137(b) be vacated due to further clarification of the Patent and Trademark Office's interpretation of the provisions of 35 USC 1.22(b)(2)(B)(ii)-(iv) that petitioner argues made the petition under 37 CFR 1.137(b) unnecessary. Petitioner maintains that 35 USC 1.22(b)(2)(B)(ii)-(iv) is interpreted such that if an applicant makes a non-publication request under 35 USC 1.22(b)(2)(B)(ii)-(iv) and then rescinds the non-publication request before or on the date a counterpart application is filed in an eighteen-month publication country, the non-publication request will be treated as annulled, and the application will be treated as if the non-publication request was never made. Petitioner, therefore, concludes that when a rescission of the non-publication request is timely filed, no notice of foreign filing is required under 35 USC 1.22(b)(2)(B)(ii)-(iv).

This is an accurate interpretation of the 35 USC 1.22(b)(2)(B)(ii)-(iv), however; it does not appear that the recession of the non-publication request was timely filed in this instance. A review of the application file revealed that the instant nonprovisional application became the subject of a counterpart application filed in an eighteen-month publication country on December 13, 2001. Further review of the application filed revealed that the Notice to Rescind was received on January 24, 2002. Although a certificate of mailing pursuant to 37 CFR 1.8 dated December 4, 2001, is noted on the Notice to Rescind, petitioner is advised a Notice to Rescind does not receive the benefit of the certificate of mailing procedures. Accordingly, the date of actual receipt by the Patent and Trademark Office of the Notice to Rescind is the date that will be used to determine whether the rescission was made before or on the date the counterpart application was filed in an eighteen-month publication country. As the Notice to Rescind was received on January 24, 2002, after the counterpart application was filed in the eighteen-month publication country, notice of foreign filing was required and, because such notice was not timely given, the petition under 37 CFR 1.137(b) filed September 30, 2003, was necessary.

The fee for the petition under 37 CFR 1.137(b) will not be refunded, however; deposit account 02-2666 will be charged \$130.00 for the instant petition fee.

Further correspondence with respect to this matter should be addressed as follows:

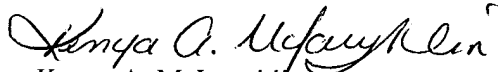
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The application will be sent to Technology Center 3600 for further processing.

Telephone inquiries should be directed to the undersigned at (703) 305-0010.


Kenya A. McLaughlin
Petitions Attorney
Office of Petitions